

REMARKS

All issues originally raised in the Office Action mailed May 24, 2004 are addressed herein.

The Examiner is thanked for the performance of a thorough search.

By this amendment, Claims 1, 3, 5-7, 9, 12, 14, 16, 17-19, 21, 23-25, 27, 30, 32, 34, and 36-42, have been amended. No claims have been added or deleted. Hence, Claims 1-42 are pending in this application. The amendments to the claims do not add any new matter to this application. Furthermore, the amendments to the claims were made to improve the readability and clarity of the claims and not for any reason related to patentability.

1. REJECTION OF CLAIMS 1-18 UNDER 35 U.S.C. § 102(b)

Claims 1-18 were rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by *Ebner et al.*, U.S. Patent Application No. US 5,384,620. It is respectfully submitted that Claims 1-18, submitted herein, are patentable over *Ebner* for at least the reasons provided hereinafter.

A. CLAIM 1

Claims 1 was rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by *Ebner*. In particular, the Office Action alleges that *Ebner* teaches Claim 1 in Col 5, lines 35-42. This is not correct. Col 5, lines 35-42 read:

“The paper size and orientation are as conventionally understood. By paper type, or tray, it should be understood that on producing a particular job, even though the paper size and orientation remain constant, different paper trays having, for example, a first page

letter head, a subsequent page letter head, a no letter head letter-quality paper or a draft-quality paper, may be desired. By identifying different types of a paper, for example, by tray, and allowing for different trays to be accessed by the paper transport during a single job, complex documents can be easily produced.”

Claim 1, as amended, requires:

“determining that a first paper source, a second paper source, and a third paper source at a printing device each currently has media available”

Nowhere in the cited section of *Ebner*, nor elsewhere in *Ebner*, is there a determination of the availability of any paper source. In *Ebner*, a document is constructed with a set of parameters, including a paper source, regardless if there is any paper available in the paper source. In *Ebner*, the choice of paper sources is made based on knowledge of *potentially available* media at paper sources, not based on what media is *currently available* at the paper sources. For example, in *Ebner*, a print job could be constructed in which *none* of the paper sources have *any* available paper. This is not the case with embodiments of Claim 1. In embodiments of Claim 1, a determination is made “that a first paper source, a second paper source, and a third paper source at a printing device each currently has media available.” Subsequently, *currently available* paper sources are selected for page ranges and this information is sent to the printing device. Such a determination is not taught by *Ebner*.

In summary, *Ebner* could not possibly teach: “determining that a first paper source, a second paper source, and a third paper source at a printing device each currently has media available.” Since 35 U.S.C. 102(b) requires that a reference teach every feature of a claim in order for the reference to anticipate the claim, and given that *Ebner* does not teach one or more of the features of Claim 1, *Ebner* could not possibly teach

Claim 1. Therefore, the withdrawal of the rejection with respect to Claim 1 is respectfully requested.

B. CLAIMS 3 and 12

Although Claims 3 and 12 are not the same as Claim 1, the Office Action alleges that Claims 3 and 12 are unpatentable for the same reasons as Claim 1. The remarks regarding the patentability of Claim 1 can also be applied to Claims 3 and 12. The applicant notes that Claims 3 and 12 were amended in a manner similar to Claim 1. Claims 3 and 12 are patentable for reasons similar to those given above for Claim 1. For example, Claim 3, as amended, requires:

“determining that a first print characteristic and a second print characteristic are currently available for use at a printing device”

As stated above with respect to Claim 1, nowhere in *Ebner* is there any disclosure or teaching of determining what is currently available at the printing device, therefore *Ebner* could not possibly teach “determining that a first print characteristic and a second print characteristic are currently available for use at a printing device”. Therefore, since 35 U.S.C. 102(b) requires that a reference teach every feature of a claim in order for the reference to anticipate the claim, and given that *Ebner* does not teach one or more of the features of Claim 3, *Ebner* could not possibly teach Claim 3. Therefore, the withdrawal of the rejection with respect to Claim 3 is respectfully requested.

Similar argument can be made for Claim 12, but are not presented herein. Nevertheless, Applicants reserve the right to present arguments at a later time in the prosecution of this application, if necessary.

Withdrawal of the rejections with respect to Claim 12 is also respectfully requested.

C. CLAIM 4, 8-10, 13, and 17

Although Claims 4, 8-10, 13, and 17 are not the same as Claim 1, the Office Action alleges that Claims 4, 8-10, 13, and 17 are unpatentable for the same reasons as Claim 1. The remarks regarding the patentability of Claim 1 can also be applied to Claims 4, 8-10, 13, and 17. Therefore, in order to expedite prosecution, Claims 4, 8-10, 13, and 17 will not be argued separately here. Nevertheless, Applicants reserve the right to present such arguments at a later time in the prosecution of this application, if necessary.

Withdrawal of the rejections to Claims 4, 8-10, 13, and 17 is respectfully requested.

D. CLAIM 7, 14, 16, and 18

The Office Action alleges that Claims 7, 14, 16, and 18 are unpatentable over *Ebner* citing the “displaying step for a user 22 or 24 in figure 1” and column 4, lines 60-62. There is no displaying step in *Ebner* in the cited sections or elsewhere. Since the 102(b) requires that the reference teach the limitations and since the displaying step is not taught in *Ebner*, the remarks herein will remark on the cited text and *Ebner* as a whole and disregard the Office Action’s reference to the undisclosed “displaying step”.

In the cited section, *Ebner* teaches:

“a job source could have been set up by an operator and stored on disk 28, set up by the operator and stored on tape 30, or a job

source or document could have been created by a network user and the information sent to the controller via the network 26.”

Claim 7, as amended, requires

“displaying a user interface that identifies a set of one or more media types that are currently available to a printing device for printing pages of the electronic document;”

The cited section of *Ebner* a document is created by a network user and is sent to the printer. As was described above with respect to Claim 1, in *Ebner* there is no knowledge of what printing options are currently available at the printer. Therefore *Ebner* could not possibly teach: “displaying a user interface that identifies a set of one or more media types that are *currently* available to a printing device for printing pages of the electronic document” (emphasis added). It is therefore respectfully submitted that Claim 7 includes one or more limitations that are not taught or suggested by *Ebner*. Therefore, *Ebner* does not anticipate Claim 7. Therefore, withdrawal of the rejection of Claim 7 is respectfully requested.

Although Claims 7, 14, 16, and 18 are not the same, the Office Action alleges that Claims 7, 14, 16, and 18 are unpatentable for the same reason. The remarks regarding the patentability of Claim 7, can also be applied to Claims 14, 16, and 18. Therefore, in order to expedite a favorable result, Claims 14, 16, and 18 will not be argued separately herein. Nevertheless, Applicants reserve the right to present such arguments at a later time in the prosecution of this application, if necessary.

Withdrawal of the rejections to Claims 14, 16, and 18 is respectfully requested.

E. CLAIMS 2, 5, 6, 11, and 15

Claims 2, 5, 6, 11, and 15 all depend directly or indirectly from Claims 1, 3, 7, 12, or 14 and include all of the limitations of the claim on which they depend. It is therefore respectfully submitted that Claims 2, 5, 6, 11, and 15 are patentable over *Ebner* for at least the reasons set forth herein with respect to the independent claim on which they depend.

Furthermore, it is respectfully submitted that Claims 2, 5, 6, 11, and 15 recite additional limitations that independently render them patentable over *Ebner*. Given the fact that Claims 1, 3, 7, 12, and 14 are allowable, dependent Claims 2, 5, 6, 11, and 15 are also allowable, and arguments concerning the additional limitations of the dependent claims are not set forth at this time. Nevertheless, Applicants reserve the right to present such arguments at a later time in the prosecution of this application, if necessary.

F. CONCLUSORY REMARKS for 35 U.S.C. § 102 AND CLAIMS 19-42

In view of the foregoing, it is respectfully submitted that Claims 1-18 are patentable over *Ebner*. Accordingly, reconsideration and withdrawal of the rejection of Claims 1-18 under 35 U.S.C. § 102(b) as being anticipated by *Ebner* is respectfully requested. Additionally, because claims 19-42 have not yet been cancelled, Applicants note that, at least for the reasons stated above in respect of Claims 1-18, Claims 19-42 are also not anticipated by *Ebner*.

2. FINAL RESTRICTION REQUIREMENT

Applicants note that the Examiner has made the requirement for restriction in this case final. However, Applicants maintain that the requirement for restriction is improper in this case. Therefore, Applicants have filed a Petition Under 37 CFR § 1.144 to request that the Honorable Commissioner for Patents review the final requirement for restriction that has been entered in this case.

3. CONCLUSIONS AND MISCELLANEOUS

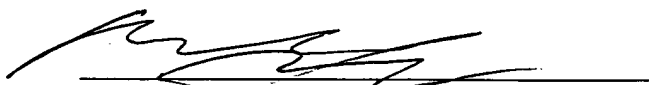
It is respectfully submitted that all of the pending claims are in condition for allowance and the issuance of a notice of allowance is respectfully requested. If there are any additional charges, please charge them to Deposit Account No. 50-1302.

The Examiner is invited to contact the undersigned by telephone if the Examiner believes that such contact would be helpful in furthering the prosecution of this application.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

Date: July 22, 2004



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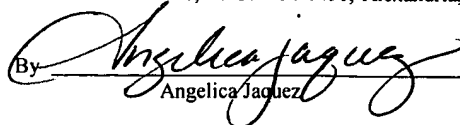
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: **Mail Stop Non-Fee Amendment**, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

On July 22, 2004

By


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